

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q112119

Hiroyuki NAKAMURA

Appln. No.: 10/571,993

Group Art Unit: 3728

Confirmation No.: 5590

Examiner: PAGAN, JENINE MARIE

Filed: March 15, 2006

For: MEDICAL TREATMENT KIT

**REQUEST FOR REFUND**

**MAIL STOP 16**

Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby respectfully requests a refund in the amount of \$405.00. This refund is to be credited to Deposit Account No. 19-4880.

The USPTO mailed an Non-Final Office Action on October 6, 2008, in which a 3 month response period was set. *See* Office Action Summary of attached copy of Office Action.

Applicant erroneously filed an Request for Continued Examination (RCE) response on March 26, 2009. The USPTO charged Applicant's deposit account in the amount of \$405.00 (small entity) for the RCE filing fee on March 27, 2009. Since the aforementioned response is not in compliance as a response to a Non-Final Office Action, Applicant is not required to pay such fee.

Respectfully submitted,

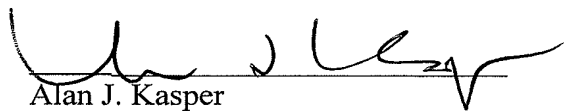
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**23373**

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Date: April 8, 2009



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,993	03/15/2006	Hiroyuki Nakamura	29336.0002	5590
27890 7590 10/06/2008 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER PAGAN, JENINE MARIE	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 10/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/571,993

**Applicant(s)**

NAKAMURA, HIROYUKI

**Examiner**

JENINE M. PAGAN

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 15 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/03/2008 has been entered.
2. This Office Action acknowledges the applicant's amendment filed 9/03/2008. Claims 1-4 are pending in the application.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 contains limitations of "stiff base portions", yet in the specification, in paragraphs 23 and 38, applicant uses the phrase "shape-retaining property". A "shape-retaining property" does not have the same meaning as "stiff" material and does not necessarily provide support for the limitation "stiff material".

The limitation is considered "new matter". Since claims 2-4 are dependent on claim 1, they are rejected under 112 1<sup>st</sup> paragraph as well.

***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d) (1) and MPEP § 608.01(o). Correction of the following is required: The specification provides no support for the terminology "stiff".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada (JP 2000-271150) in view of Koizumi (JP 2002-1022252) both included in the IDS received from Applicant.

Claim 1: Terada discloses a medical kit:

- a medicinal solution housing container 11 having a medicinal solution housing chamber for housing a medicinal solution 41, and said medicinal solution housing chamber being closed by a first covering material 8
- a medical instrument housing portion 3, separate from said medicinal solution housing container 11, comprising a medical

instrument housing chamber for housing a medical instrument 31, said medical instrument housing chamber being closed by a second covering material 8 different from said first covering material (Para 0021 and Fig. 3)

- the medicinal solution housing 11 and the medical instrument housing 3 comprise stiff base portions 15/13,
- the medicinal solution housing comprises a first shape having a cut-out portion (see figure above)
- the medical instrument housing portion comprises a second shape corresponding to the cut-out portion (see figure above)
- the first covering material 8 does not overlap the second covering material 8 (Para 0021 and Fig. 3)

Terada does not disclose:

- the medicinal solution housing container is removeably attached to the medical instrument housing portion, such that the medicinal solution housing container can be detached from the medicinal instrument housing portion without removing the second covering material from the medicinal solution housing container, and such that the stiff base portion of the medicinal solution housing attaches to the stiff base portion of the medical instrument housing

However Koizumi discloses:

- the medicinal solution housing container 3 is removeably attached to the medical instrument housing portion 2, such that the medicinal solution housing container 3 can be detached from the medicinal instrument housing portion, and such that the stiff base portion of the medicinal solution housing 3 attaches to the stiff base portion of the medical instrument housing 2

Koizumi discloses that it is known in the art to provide a container that has a separate container that can be detached from it. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the separate lids and separate compartments of Terada with the detachable compartments of Koizumi, in order to provide a container that you can remove one compartment of a container and use the contents without disturbing the contents of the other compartment during use. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPO 177, 179.

Claim 2: Koizumi discloses a medical kit:

- the medical instrument housing container 2 comprises a flange portion 5 for mounting said medical solution housing container 3 to said medical instrument housing container 2

Claim 3: Terada discloses a medical kit:

- the medicinal solution housing chamber 11 holds a medicinal solution 41 and the medical instrument housing chamber 3 holds at least one sterilized medical instrument 31

Claim 4: Terada discloses a medical kit:

- the medicinal solution housing chamber 11 holds a medicinal solution 41 and the medical instrument housing chamber 3 holds at least one sterilized medical instrument 31

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE M. PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/  
Primary Examiner, Art Unit 3728

/Jenine M Pagan/  
Examiner, Art Unit 3728

/J. M. P. /  
Examiner, Art Unit 3728